

REMARKS

Claims 1-19, 21-31, 33, 34, 49-60, 72-75, and 78-87 were pending in this application when the present Office Action was mailed. Claim 78 has been amended to clarify certain features of this claim. Claims 9, 22, 33, 73, and 84 have been amended solely to correct the antecedent basis of certain features of these claims. Accordingly, claims 1-19, 21-31, 33, 34, 49-60, 72-75, and 78-87 remain pending in the application.

In the non-final Office Action mailed July 22, 2005, claims 1-19, 21-31, 33, 34, 49-60, 72-75, and 78-87 were rejected. More specifically, the status of this application in light of the July 22 Office Action is as follows:

(A) Claims 9, 22, 33, 73, and 84 stand objected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention;

(B) Claims 1-19, 21-31, 33, 34, 49-60, 72-75, and 78-87 stand rejected under the nonstatutory, judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,592,443; and

(C) Claims 1, 2, 4-8, 10-19, 22, 49-55, 58-60, 72, 74, 78-81, and 83-87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's alleged admission in the Background of the present application (the "Background Disclosure").

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on October 18, 2005 to discuss the present Office Action and the pending claims. The following remarks summarize and expand upon the results of the telephone interview, and they also reflect the agreements reached between the undersigned attorney and the Examiner during the telephone interview. For example, the following remarks reflect the Examiner's acknowledgment that the Background Disclosure does not teach or suggest an energy-sensitive planarizing pad material and, accordingly, cannot support a Section 103 rejection of independent claims 1, 23, 49, 72, 78, and 85 and claims depending therefrom.

A. Response to the Section 112 Rejection of Claims 9, 22, 33, 73, and 84

Claims 9, 22, 33, 73, and 84 stand objected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. More specifically, the Office Action asserts that several features of claims 9 and 73 lack antecedent basis, and the phrase "the stations" in the last line of claims 22, 33, and 84 should instead read "the one or more stations." (Office Action, p. 2.) The claims have been amended in accordance with the Examiner's suggestions and, accordingly, the Section 112 rejection of claims 9, 22, 33, 73, and 84 should be withdrawn.

B. Response to the Obviousness-Type Double Patenting Rejection

Claims 1-19, 21-31, 33, 34, 49-60, 72-75, and 78-87 stand rejected under the nonstatutory, judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,592,443 (the "'473 patent"). The present application is a divisional application of the '473 patent, which was subject to a Restriction Requirement on March 12, 2002. In the March 12 Restriction Requirement, the Examiner required election of one of the following groups: (1) claims 1-60 and 72-75, drawn to a method for forming a planarizing pad; (2) claims 61-71, 76, and 77, drawn to a method for planarizing a microelectronic substrate; and (3) claims 78-87, drawn to a planarizing pad. The Examiner further required election of one of the following species: (1) Figures 3A-3D; and (2) Figure 4. Groups I and III, and Species I were elected in the '473 patent, while the present application is directed toward Groups I and III, Species II.

Section 806 of the MPEP states that "[w]here restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct." (MPEP § 806; emphasis added.) Because the Examiner and the U.S. Patent and Trademark Office are bound to the finding of non-obviousness between each of the species, the double patenting rejection of claims 1-19, 21-31, 33, 34, 49-60, 72-75, and 78-87 should be withdrawn.

C. Response to the Section 103 Rejection of Claims 1, 2, 4-8, 10-19, 22, 49-55, 58-60, 72, 74, 78-81, and 83-87

Claims 1, 2, 4-8, 10-19, 22, 49-55, 58-60, 72, 74, 78-81, and 83-87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Background Disclosure. As stated above, the Examiner acknowledged during the October 18th telephone interview that the Background Disclosure cannot support a Section 103 rejection of independent claims 1, 23, 49, 72, 78, and 85 and claims depending therefrom. Accordingly, the Section 103 rejection of claims 1, 2, 4-8, 10-19, 22, 49-55, 58-60, 72, 74, 78-81, and 83-87 should be withdrawn.

Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicant respectfully requests reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3982.

Respectfully submitted,

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